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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/821,041 | 04/08/2004 | Colin T. Metcalfe | 50180 | 9253 |
| 22929 | 7590 | 05/31/2006 | EXAMINER | |
| SUE Z. SHAPER, P.C. 1800 WEST LOOP SOUTH SUITE 1450 HOUSTON, TX 77027 | | | | ARK, DARREN W |
| | | ART UNIT | | PAPER NUMBER |
| | | 3643 | | |

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/821,041 | METCALFE, COLIN T. | |
| | Examiner | Art Unit | |
| | Darren W. Ark | 3643 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 and 23-43 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 and 23-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Inventorship

1. The Examiner would like to indicate that there are issues with the inventorship in this application since the inventors of U.S. Pat. Application 09/736,023 of Howse et al. have not signed and executed the Oath filed 5/17/2004 and that Mr. Colin T. Metcalfe represents an entirely new inventor who was not an inventor on U.S. Pat. Application 09/736,023. Therefore this application cannot be considered to be a properly executed Continuation of U.S. Pat. Application No. 09/736,023.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7, 23-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 18-44, 46-48, and 50 of copending Application No. 09/736,023. Although the conflicting claims

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are not identical, they are not patentably distinct from each other because a method of trapping insects comprising using a particulate composition vs. particles comprising at least one magnetic material in an electromagnetically sensitive material which includes strontium ferrite vs. a magnetic material; a cockroach affecting composition/pesticidal composition in particulate form which includes electromagnetically sensitive particles with a magnetic material which includes strontium ferrite vs. a core being impregnated or coated with a magnetic material; an insect trap having a composition comprising a magnetic material in the electromagnetically sensitive particles which includes strontium ferrite vs. a composition including particles comprising a magnetic material of opposite polarity to that of the magnetically polarized material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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In regard to claim 37, the specification and figures do not disclose the composition located upon a surface within the building, drain, or sewer.

6. Claims 37, 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regard to claim 37, the specification contains no disclosure of the composition including a building, drain or sewer or any specific structure that the desired invention is to be used with except for the trap.

In regard to claim 42, there is no disclosure in the specification of the ratio of hard material to soft material being less 1 to 2 by weight. There is only disclosure of the ratio being 1 to 9 (at spec. pg. 12, lines 10-12).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 33, 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 33, the claim requires a period at the end.

In regard to claims 35-37, the preamble of these claims do properly set forth these inventions since a composition can not be claimed as including either a surface, a

trap, or a building, drain or sewer. Applicant is attempting to recite a system for controlling insects rather than merely a composition.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 4, 5, 7, 23-27, 30, 32-38 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Latwesen 6,176,033.

Latwesen discloses a method of controlling insects (method not being particularly claimed) comprising including in the particulate composition (12, 12a-c) at least one pesticide or insect behavior modifying chemical (fish attractant can include food type attractants as disclosed at col. 3, lines 16-20; fish attractant is capable of altering the behavior of flies or roaches which are attracted to food sources) and at least one magnetized magnetic material (ferromagnetic components comprising one or more of iron, nickel, and cobalt and also magnets themselves); and locating the composition proximate a path of the insect (vessel 10, 10a-c is located at a fishing location which could be in the path of an insect).

In regard to claims 2 and 38, Latwesen discloses that small particles can be more easily homogenously dispersed throughout a fish bait than large particles and that

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the particles having a minimum dimension of greater than 0 inch and a maximum dimension of less about 0.25 inch (see col. 4, lines 43-45; .25 inch=6350 micrometers).

In regard to claim 5, Latwesen discloses the composition comprising at least 10% by weight (see col. 4, lines 45-50) of hard magnetic material ("hard" is a relative term).

In regard to claim 23, Latwesen discloses a trap comprising a housing (10, 10a-c), a zone of the housing or a zone within the housing having a composition comprising electromagnetically sensitive particles (12, 12a-c) and including in the composition a magnetic material (ferromagnetic components comprising one or more of iron, nickel, and cobalt and also magnets themselves).

In regard to claims 24 and 25, Latwesen discloses a zone of the housing including a magnetically polarizable material comprising a removable insert (one of the individual particles of 12, 12a-c or hooks 14, 14a-c, 30, 100).

In regard to claim 26, Latwesen disclose the zone having a surface inclined to horizontal (vertical walls of 10, 10a-c or surfaces of hooks 14, 14a-c, 30, 100).

In regard to claim 30, Latwesen discloses the trap structured to trap roaches (walled container 10, 10a-c).

In regard to claim 32, Latwesen discloses a composition comprising an effective insect-adhering amount of a magnetized magnetic material (ferromagnetic components comprising one or more of iron, nickel, and cobalt and also magnets themselves), combined with at least one of a pesticide and an insect behavior modifying chemical (fish attractant can include food type attractants as disclosed at col. 3, lines 16-20; fish

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attractant is capable of altering the behavior of flies or roaches which are attracted to food sources).

In regard to claims 32 and 33, the term "hard" and "soft" are relative terms.

In regard to claim 35, Latwesen discloses a surface (hook 14, 14a-c, 30, 100).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3, 5/2, 5/3, 6, 28, 29, 31, 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latwesen 6,176,033.

In regard to claims 3, 28, 31, 39, and 40, Latwesen discloses using ferromagnetic components comprising one or more of iron, nickel, and cobalt and also magnets themselves, but does not disclose the magnetized material comprising a ferromagnetic oxide, strontium ferrite or a ferrosilicate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a ferromagnetic oxide or strontium ferrite, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because ferromagnetic oxides and silicates are materials exhibiting magnetic properties that can be found in particulate form and strontium ferrite is an alloy exhibiting magnetic properties and would be employed by a

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person of ordinary skill in the art depending upon the ultimately desired composition. *In re Leshin*, 125 USPQ 416.

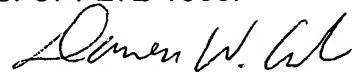
In regard to claims 42 and 43, Latwesen discloses the use of metal filings (hard), powder (hard), powder (hard) trapped in a polymer, and wherein at least some of the magnetizable particles can be in the form of particles of a flexible magnet (soft), but does not disclose the ratio of hard material to soft material being less than 1 to 2 by weight or 1 to 9 by weight. It would have been an obvious matter of design choice to modify the composition of Latwesen such that the ratio of hard material to soft material is less than 1 to 2 by weight or 1 to 9 by weight, since applicant has not disclosed that by doing so produces any unexpected results and because a person of ordinary skill in the art would readily alter the composition in order to obtain the desired product consistency and characteristics.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (571) 272-6885. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Darren W. Ark
Primary Examiner
Art Unit 3643

DWA